

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups or shown that a burden exists in searching all the claims.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as "process of making and product made." Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process such as "lamination, pressing or sputtering". However, there is no evidence of record to show that the claimed separator of a proton exchange fuel cell could be made as the Office has alleged. If, in fact, the claimed separator of a proton exchange fuel cell can be made by "lamination, pressing or sputtering", the Office has failed to show that the alleged process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Further, Applicants respectfully traverse the Restriction Requirement on the grounds that the Office has not shown that a burden exist in searching all of the claims. Applicants respectfully point out that thousands of U.S. patents have issued in which many more than two subclasses are searched, and the Office cannot reasonably assert that a burden exists in searching only two subclasses.

Moreover, the MPEP in §803 states as follows:

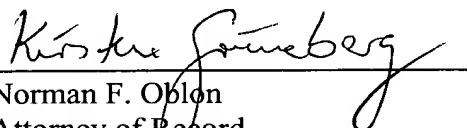
“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Kirsten A. Grueneberg, Ph.D.
Registration No.: 47,297



22850

PHONE NO.: (703) 413-3000
FAX NO.: (703) 413-2220
NFO:KAG:lcd

I:\user\KGRUN\00397444ttc.rest.resp.wpd